

REMARKS

Claims 1-34 were originally filed in the present application. Of the pending claims, Claims 1 and 3-13 were initially rejected under 35 U.S.C. 112, first paragraph, as being non-enabled by the specification (paragraph no. 6 of Office Action). Similarly, Claims 1-34 were initially rejected under 35 U.S.C. 112, first paragraph, as being non-enabled by the specification (paragraph no. 7 of Office Action). Claims 1-13 have been initially rejected under 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 1 recited the phrase "a positive or negative test result" causing some confusion as to the invention. Claim 4 lacked proper antecedent basis for the phrase "prion protein." Claim 11 was missing the term "of" within the phrase "at least a portion the test device." No substantive rejections under 35 U.S.C. 102 or 103 have been made.

Additionally, the drawings and specification have been objected to because of a number of inadvertent errors.

Accordingly, Claims 1, 4, 6, 7, 11, 14, 16, 22, 23, 25, and 28 have been amended. Several passages in the specification have also been amended to correct the objectionable informalities.

With respect to the claims rejected under 112, first paragraph, the Examiner felt that the original claims were overly broad in light of the specification. The Examiner has noted that the present application is "enabling for detection of prion disease utilizing antibodies which are specific for PrP^{SC}". Accordingly, the claims have been amended to specifically limit the scope to detection of prion disease in animal carcasses utilizing antibodies specific for PrP^{SC}. No new matter has been added.

With respect to the claims rejected under 112, second paragraph, Claims 1 and 11 have been amended. Specifically, the Examiner believed step (g) of Claim 1 was unclear, as it appeared to require removal of all carcasses, i.e., whether positive or negative for disease. The intent of this limitation was to cover the two possible cases of removal. That is, either the carcasses that test positive would be removed leaving only negative test carcasses, or only negative test carcasses would be removed leaving only positive test carcasses. Accordingly, Claim 1 has been amended to

Page 12

read “so the carcass having a positive test result may be separated from a carcass having a negative test result.” Claim 11 has been amended as suggested by the Examiner. No new matter has been added to these claims.

As to the informalities, several sections of the specification, including the drawing description section, have been amended to address objections made by the Examiner. Specifically, the descriptions for Figures 1-4 have been amended as suggested by the Examiner. Further, reference numbers “28” and “312” have been added to the specification, while reference numbers “13” and “228” have been amended or removed. The reference number “28” is directed to a spacer pad similar to related spacer pad 328. The “228” reference number has been deleted, as it was intended to reference spacer pad 28. Reference number “312” was added to describe the test strip of Figure 4, not unlike the test strip 12 of Figure 1. Finally, number “13” was amended to reference the strip support 313 shown in Figure 4. These were merely inadvertent typographical errors made during preparation of the pending application, and those skilled in the relevant art would readily understand the intended reference. No new matter has been added.

While not amended, replacement drawings are also being submitted herewith. These replacement drawings are formal drawings labeled with the phrase “REPLACEMENT SHEET” in accordance with the new requirements.

Reconsideration of all pending claims is respectfully requested in light of the above amendments.

U.S. Application No. 09/990,773
Inventor: Hajizadeh, K.
Attorney Docket No. 3873 P 011

Page 13

CONCLUSION

Claims 1-34 are presently pending in the referenced application. Claims 1, 4, 6, 7, 11, 14, 16, 22, 23, 25, and 28 have been amended. Applicant believes that all pending claims are allowable, and a notice to that effect is earnestly sought at the Examiner's earliest convenience. Reconsideration of all pending claims is hereby requested. If any informalities remain which may be cleared up by Examiner amendment, Applicant requests the Examiner to call the undersigned attorney at his convenience.

The Commissioner is authorized to debit or credit our Deposit Account No. 23-0280 for any payment **deficiencies or overpayments** associated with this matter.

Respectfully submitted,

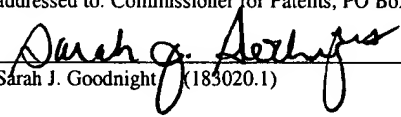
Date: September 12, 2003

By: 

Robert W. Diehl, Reg. No. 35,118
Customer No. 26851
Wallenstein Wagner & Rockey, Ltd.
311 South Wacker Drive, 53rd Floor
Chicago, Illinois 60606-6622
312.554.3300

CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on September 12, 2003.


Sarah J. Goodnight (183020.1)